

REMARKS/ARGUMENTS

Claims 1-18 are pending in the present application. In the Office Action mailed June 28, 2005, the Examiner rejected claims 1-18 under 35 U.S.C. § 103(a).

Reconsideration is respectfully requested in view of the above amendments to the claims and the following remarks.

I. Rejection of Claims 1, 2, 5, 7, 9-12, 15 and 18 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1, 2, 5, 7, 9-12, 15 and 18 under 35 U.S.C. § 103(a) based on PCT Publication No. WO 98/53581 to Gaw *et al.* (hereinafter "Gaw"). This rejection is respectfully traversed.

The M.P.E.P. states that

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142.

Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. First, Applicants submit that the Examiner has not met his burden in showing why one of ordinary skill in the art, without having any knowledge of the claimed invention, would have been

led to modify Gaw's server (12) so that the HTTP server determines "whether third party software is necessary to process a data request sent by the web client." Gaw's system is designed to translate data into an out of a generic control protocol. Gaw's system teaches all of the required modules that are used to make this translation. As such, there is no reason why one skilled in the art would modify Gaw's system so that it would determine whether third party software is necessary to service a device request.

More importantly, independent claims 1 and 10 have been amended to recite that "the server is further configured to determine whether it has sufficient information and functionality to service the device request, and if yes, the server will service the device request without communicating with the gateway." Support for this limitation is found throughout Applicants' specification including, for example, page 11, lines 8-12, page 15, lines 7-9, and Figure 16. Applicants respectfully submit that Gaw does not teach or suggest this claimed limitation.

Specifically, Gaw discloses a server system (12) that accesses control data through web browsers over a network, communicates with various devices (20-28), and performs protocol conversion by translating data to and from a generic control protocol. *See e.g.*, Gaw, p. 1, lines 9-12. This disclosure regarding the server (12), however, does not teach that the server (12) determines whether or not it "has sufficient information and functionality to service the device request" or that if such sufficient information/functionality is present, that the server "will service the device request without communicating with the gateway."

Accordingly, because Gaw does not teach that the server determines "whether it has sufficient information and functionality to service the device request, and if yes, the server will service the device request without communicating with the gateway," all of the claim elements found in independent claims 1 and 10 are not taught or suggested by Gaw. As such, this reference cannot render claims 1 and 10 *prima facie* obvious under 35 U.S.C. § 103(a). Withdrawal of this rejection is respectfully requested.

With respect to dependent claims 2, 5, 7, and 9, these claims depend either directly or indirectly from claim 1. Likewise, claims 11-12, 15 and 18 depend either directly or indirectly from claim 10. Accordingly, Applicants respectfully request that the rejection of dependent claims 2, 5, 7, 9, 11-12, 15 and 18 be withdrawn for at least the same reasons as those presented above in connection with claims 1 and 10.

II. Rejection of Claims 3, 4, 8, 13, 14 and 17 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 3, 4, 8, 13, 14 and 17 under 35 U.S.C. § 103(a) based on Gaw in view of U.S. Patent No. 6,336,137 to Lee *et al.* (hereinafter “Lee”). This rejection is respectfully traversed.

As noted above, a claim cannot be rejected as being obvious under 35 U.S.C. § 103(a) unless all of the claimed limitations are taught or suggested in the prior art. *See e.g.*, M.P.E.P. § 2142. Here, Applicants submit that the cited references do not teach or suggest all of the limitations found in claims 3, 4, 8, 13, 14, and 17. Specifically, as explained above, Gaw does not teach or suggest the limitation that “the server is further configured to determine whether it has sufficient information and functionality to service the device request, and if yes, the server will service the device request without communicating with the gateway.” Likewise, Applicants can find no teaching or suggestion in Lee that relates to this claim element. Consequently, the combination of Gaw and Lee does not render claims 3, 4, 8, 13, 14, and 17 obvious under 35 U.S.C. §103(a). Withdrawal of this rejection is respectfully requested.

III. Rejection of Claims 6 and 16 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 6 and 16 under 35 U.S.C. § 103(a) based on Gaw in view of U.S. Patent No. 5,956,487 to Venkatraman *et al.* (hereinafter “Venkatraman”). This rejection is respectfully traversed.

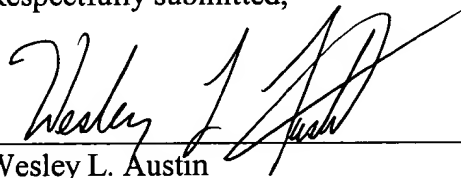
Again, a claim cannot be rejected as being obvious under 35 U.S.C. § 103(a) unless all of the claimed limitations are taught or suggested in the prior art. *See e.g.*, M.P.E.P. § 2142. Here, Applicants submit that the cited references do not teach or suggest all of the limitations found in claims 6 and 16. Specifically, as explained above, Gaw does not teach or suggest the limitation that “the server is further configured to determine whether it has sufficient information and functionality to service the device request, and if yes, the server will service the device request without communicating with the gateway.” Likewise, Applicants can find no teaching or suggestion in Venkatraman that relates to this claim element. Consequently, the combination of Gaw and Venkatraman does not render claims 6 and 16 obvious under 35 U.S.C. §103(a). Withdrawal of this rejection is respectfully requested.

Appl. No. 09/755,348
Amdt. dated September 27, 2005
Reply to Office Action of June 28, 2005

IV. Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Wesley L. Austin', is written over a horizontal line.

Wesley L. Austin
Reg. No. 42,273
Attorney for Applicant

Date: September 27, 2005

MADSON & METCALF
Gateway Tower West
15 West South Temple, Suite 900
Salt Lake City, Utah 84101
Telephone: 801/537-1700